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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,106	11/09/2001	Daniel K. Schiffer	KCC-15,891	3014
35844	7590	08/25/2004	EXAMINER	
PAULEY PETERSEN & ERICKSON 2800 WEST HIGGINS ROAD HOFFMAN ESTATES, IL 60195			SPERTY, ARDEN B	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,106

Applicant(s)

SCHIFFER ET AL.

Examiner

Arden B. Sperty

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-26,31,35-54 and 56-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-26,31,35-54 and 56-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

NON-FINAL REJECTION

1. Amendment and Remarks dated 05/06/04 have been entered and carefully considered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 54 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear which biodegradable thermoplastic polymer of claim 53 is referred to by claim 54, since both the film layers and the nonwoven web of claim 53 include a biodegradable thermoplastic polymer. For purposes of examination, the claim is interpreted as "...wherein the biodegradable polymers are selected from..." (emphasis added).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 21-22, 24-26, 31, 35-36, 38-42, 44-49, 53-54, 56-58 are rejected under 35 U.S.C. 102(a) as being anticipated by USPN 6,261,674 to Branham et al.

6. Branham teaches a breathable laminate comprising a breathable stretch-thinned film (col 3, lines 27-30). Said film comprising a filler and voids formed around the filler particles to facilitate passage of water vapor through the film (col 8, lines 2-9).
7. The laminate comprises a fibrous nonwoven polypropylene web, which can be spunbond or meltblown (col 15, lines 12-14 and 43-48). Applicant teaches use of the same material in the specification, at the top of page 18. Whether or not the reference suggests a property of the composition is immaterial where the prior art composition is the same as that claimed. *Titanium Metals Corp. of America v. Banner* (CAFC 1985) 227 USPQ 775.
8. The film and nonwoven web are adhesively bonded together (col 15, lines 33-35).
9. The laminate comprises applicant's claimed biodegradable thermoplastic polymer (col 5, lines 53-60).
10. The laminate is used in applicant's claimed uses (col 15, lines 15-21).
11. The filler comprises calcium carbonate, organic fillers, and water-swellaable fillers (col 8, lines 18-32) used in applicant's claimed proportions (col 8, lines 44-45).
12. Branham teaches uniaxial and biaxial stretching (col 4, line 39).
13. One layer of the multi-layer film can act as a skin layer (abstract).
Both layers contain filler particles (col 7, lines 60-61).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Branham as applied to claim 21 above, and further in view of U.S. 6050985 to Lavon et al.

16. Branham is silent with respect to thermally bonding the film and nonwoven web together. Lavon teaches thermally bonding a nonwoven and film together (col 19, lines 29-33) in a similar use. Lavon teaches thermal bonding as functionally equivalent to adhesive bonding. It would have been obvious to one of ordinary skill in the art to select from either of these known equivalents. The skilled artisan would have been motivated to choose thermal bonding over adhesive bonding by the desire to reduce costs by eliminating the need for adhesives.

17. Claims 37, 50-52 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Branham in view of US 6514602 to Zhao et al.

18. Branham teaches the use of biodegradable polymers and water dispersible polyesters and copolyesters, but does not specifically teach terpolymers of butandiol, terephthalic acid or adipic acid.

19. Zhao teaches water-dispersible, biodegradable films of similar use as Branham (abstract). Zhao teaches films from the water dispersible, biodegradable polymers claimed by Applicant (col 7, lines 1-8). The films used by Zhao are the same films sold by Eastman Chemical Company as used by applicant (p.10, lines 1-4 of applicant's

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specification). It would have been obvious to a person having ordinary skill in the art to utilize the polymers taught by Zhaso as the copolyesters of Branham. Such a combination would have been motivated by the desire to create a water0flushable, biodegradable film with "extremely desirable mechanical properties including the ability to be stretched and elongated without tearing or ripping, and sufficient softness and flexibility to provide comfort for the wearer without excessive noise generation during use" (col 7, lines 13-20).

20. Regarding claim 55, it would have been obvious to a person having ordinary skill in the art to make both film layers of Branham from biodegradable polymers. Such modification would have been motivated by the desire to render the laminate water-dispersible and environment-friendly.

Response to Arguments

21. Applicant's arguments filed 05/06/04 have been fully considered but they are not persuasive, as explained herein.

22. Regarding the 35 USC 102(a) rejection of claims 21, 22, 24-26, 31, 35,36,38-42,44-49,53-54,56-58, the examiner agrees with Applicant's statement on page 7 that the Branham reference teaches an inherently biodegradable material as the first polymer. Therefore the limitation requiring a biodegradable thermoplastic polymer film is met. Whether or not the reference suggests a property of the composition is immaterial

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where the prior art composition is the same as that claimed. *Titanium Metals Corp. of America v. Banner* (CAFC 1985) 227 USPQ 775.

23. The examiner further agrees that the materials cited by Applicant as used for the second (less breathable) polymer are not biodegradable. However, column 7, line 8, lists polyethylene terephthalate as an exemplary material. PET is biodegradable (see Biodegradable Plastics article, page 1). Applicant further attests that the first and second polymers must be different polymers since they have different water vapor transmission rates. The examiner disagrees, as water vapor transmission rates may also differ according to porosity, even if the polymers are the same. The Brenham reference teaches factors, other than polymer composition, which may contribute to breathability (col 14, line 66-col 15, line 12).

24. Applicant attests on page 8 of the Remarks, that the fibrous nonwoven polypropylene web (liner layer **130**), taught by the Brenham reference at column 15, lines 38-52 (not col 6, lines 4-8, as cited by Applicant), is not biodegradable. However, it is respectfully submitted that Applicant teaches use of the same material in the specification (see top of page 18), therefore the claim limitation is met. Whether or not the reference suggests a property of the composition is immaterial where the prior art composition is the same as that claimed. *Titanium Metals Corp. of America v. Banner* (CAFC 1985) 227 USPQ 775.

25. Remarks on pages 9-11 of applicant's response argue the combinations of Branham/Lavon, Branham/Zhao, and Branham/Trinh, based on Branham's alleged failure to teach a biodegradable nonwoven web. However, as stated above, Branham

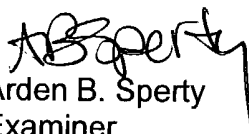
teaches use of the same material, polypropylene, as in applicant's specification (see top of page 18). Whether or not the reference suggests a property of the composition is immaterial where the prior art composition is the same as that claimed. *Titanium Metals Corp. of America v. Banner* (CAFC 1985) 227 USPQ 775.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arden B. Sperty whose telephone number is (571)272-1543. The examiner can normally be reached on M-Th, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571)272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Arden B. Sperty
Examiner
Art Unit 1771

August 19, 2004


Ms. Arti R. Singh
Primary Examiner
Tech Center 1700